

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	:	Robert Bruce Spertell
App. No	:	09/637,923
Filed	:	August 14, 2000
For	:	METHOD AND APPARATUS FOR TREATING SUBCUTANEOUS HISTOLOGICAL FEATURES
Examiner	:	Fadi H. Dabour
Art Unit	:	3742

STATEMENT OF BRYAN WAHL SUPPORTING UNINTENTIONAL ABANDONMENT
UNDER 37 C.F.R § 1.137(b)

I, Bryan Wahl, do hereby state as follows:

1. I am a citizen of the United States, and am an attorney at the law firm of Knobbe Martens Olson & Bear LLP, intellectual property counsel for Miramar Labs, Inc., the current assignee of the above-captioned application by virtue of the chain of title discussed below. I received a law degree from the University of California, Berkeley (Boalt Hall) School of Law, am a member of the State Bar of California and am registered to practice before the USPTO. My mailing address is 1 Sansome St., Suite 3500, San Francisco, CA 94104.

2. I have reviewed the Decision on Petition mailed May 30, 2008 dismissing the petition to revive the above-identified application under 37 C.F.R. § 1.137(b).

3. Around August 2007, Sabing Lee, a partner at my firm, and I were asked by Mark Deem, the Chief Executive Officer of Miramar Labs, to research the status of various patents and applications of interest, including the above-identified application. I verified that the present application was a divisional of U.S. Pat. Application No. 08/904,175, now U.S. Patent No. 6,104,959 (the “‘959 patent”) to Robert B. Spertell. The ‘959 patent was the parent application of the ‘923 Application, and was assigned from Spertell to Microwave Medical Corporation. The assignment document expressly assigned all divisional applications (i.e., the present application)

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to Microwave Medical as well, and was recorded in the United States Patent and Trademark Office on July 31, 1997 at Reel 008662 and Frame 0965.

4. I further reviewed documents indicating that both MW Medical, Inc. and Microwave Medical Corporation filed for Chapter 11 bankruptcy in the District Court of Arizona (No. 02-01090-ECF-RTB and 02-01298-ECF-GBN) on January 22, 2002. I discovered that at least in part because Microwave Medical Corporation was a wholly-owned subsidiary of MW Medical, Inc., the bankruptcy cases were consolidated. Thus, the assets and claims of the two entities were likewise consolidated. The successor company MW Medical, Inc. emerged from bankruptcy on November 19, 2002. None of the bankruptcy documents nor PTO assignment records indicated that any of the intellectual property had been assigned to a third party by the close of bankruptcy, thus any assets of Microwave Medical would be owned by MW Medical, Inc. following bankruptcy.

5. After obtaining the file history of the above-captioned application, I discovered that the above-identified application had gone abandoned on September 6, 2002 for failure to respond to an Office Action mailed June 5, 2002. See Exhibit 12.

6. Upon review of public Security and Exchange Commission databases, I found an assignment agreement that specified all intellectual property on the books of MW Medical, Inc. as of March 15, 2003 was assigned to Jan Wallace.

7. I informed Mark Deem of my findings regarding the aforementioned application, including the fact that the above-captioned application had gone abandoned. After an extended period of negotiations lasting from November 2007 until January 2008, Wallace assigned her rights to the present application, among other assets, to Miramar Labs, Inc. by virtue of an assignment agreement dated January 24, 2008.

8. Immediately following the assignment of the above-captioned application to Miramar Labs, Inc., Deem instructed me to begin preparing a petition to revive the application, and to contact the appropriate parties to verify that the application was in fact unintentionally abandoned.

9. Circa February 2008, I interviewed via telephone Grace Sim, Jan Wallace, Raymond Bogucki, and Douglas Hanscom to learn more regarding the circumstances of the abandonment of the above-identified application.

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10. Bogucki, a solo practitioner, and Hanscom of Jones Tullar and Cooper, P.C. are patent attorneys that were involved with the prosecution of the above-captioned application. Their sole contact person at Microwave Medical and MW Medical was the Chief Financial Officer of both companies, Sim. After talking with Bogucki and Hanscom, and later reviewing Hanscom's files, I found that Hanscom had mailed a copy of the Office Action mailed by the USPTO on June 5, 2002 for the above-identified application to Sim along with a cover letter requesting instructions, but the letter had been returned to sender. Up until the date of abandonment on September 6, 2002 (and beyond as discussed below), Hanscom and Bogucki stated that they attempted to contact Sim, but were not successful. As both attorneys stated that they were under the impression that MW Medical, Inc. was defunct, neither attorney had any means to communicate with their client so as to receive instructions on how to proceed with the application and as such did not know their client's intention regarding the above-identified application, no response was filed to the Office Action, and the application was abandoned on September 6, 2002. Neither patent attorney reported knowing that the rights to the above-identified application had been assigned to Wallace in 2003, and in fact no one had contacted them regarding the above-identified application until they were contacted by Deem in late 2007.

11. Sim stated that she was the Chief Financial Officer of Microwave Medical and MW Medical, Inc. and told me that she was solely in charge of managing the companies' intellectual property from circa 1999 until 2004. She indicated that she did not receive any notice from Hanscom or Bogucki regarding the Office Action, and in fact, she personally does not recall receiving any correspondence related to the above-captioned application at all. Sim confirmed that MW Medical's Scottsdale, AZ headquarters was vacated circa April 2002 because of financial reasons. Sim indicated that she was unaware that the patent had gone abandoned on September 6, 2002, and did not seek to file a petition to revive the application while Microwave Medical Corporation or MW Medical, Inc. was the assignee.

12. Wallace stated that she was the President and Chief Executive Officer of both Microwave Medical Corporation and MW Medical, Inc. but delegated management of the intellectual property to Sim. Wallace confirmed that the rights to all intellectual property on the books of Microwave Medical and MW Medical, including that of the above-captioned application, were assigned to her in exchange for a reduction in the amount of debt that was owed to her. Wallace acknowledged that she had minimal experience with the patent process and

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believed that all patents were issued and that no further action was required to keep them in force. Thus, she did not recall contacting or being contacted by Hanscom or Bogucki. In fact, she did not know the above-captioned application had gone abandoned until being informed by Deem in late 2007.

13. Immediately after confirming the circumstances surrounding the abandonment of the above-captioned application from the aforementioned individuals, I concluded that the application was indeed abandoned unintentionally. I then, along with Sabing Lee, diligently prepared the petition to revive an application unintentionally abandoned under 37 C.F.R. § 1.137(b), along with the requisite amendment and response to the Office Action mailed June 5, 2002. The petition to revive electronically filed with the USPTO on March 7, 2008.

14. I believe that the entire delay from the time of the abandonment of the '923 Application, to the filing of the revival petition on March 7, 2008 was unintentional.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

Date: 9/30/08



Bryan Wahl
Patent Attorney
Knobbe Martens Olson & Bear LLP

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